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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/579,845

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Walter Rosenbaum

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EXAMINER
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CHEN, GEORGE YUNG CHIEH

ART UNIT	PAPER NUMBER
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3628

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/579,845	<b>Applicant(s)</b> ROSENBAUM, WALTER	
	<b>Examiner</b> George Chen	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/05/2009</u> .  | 6) <input type="checkbox"/> Other: _____                          |

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**1. DETAILED ACTION**

2. This communication is a final action in response to amendment filed on 10/29/2009.

Claims 1-5, 7-11 are pending.

**3. Information Disclosure Statement**

4. The information disclosure statement (IDS) submitted on 10/05/2009 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

**5. Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lubart (US 20050192913 A1) in view of Schoeffler (US 20010049745 A1)**

8. As per claim 1, Lubart discloses a method of forwarding post, comprising the steps of:

- ✓ providing a post forwarding apparatus for scanning an address face of the post for a TAG ID and consulting a database for records related to the TAG ID, the records indicating said TAG ID is expired and if a redirection fee has been paid (see at least Lubart, 0014, the follow me mail service allows a user to define where mail objects that are addressed to a registered pseudo name are delivered. a user can modify their profile. and see at least 0022, each profile and one or more sub profile comprise a

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valid date range defining when the profile and one or more sub profiles are active and therefore a user can set a date range for a mail service. And see at least 0078, if a mail object is sent as second class mail Hadley's franking profile is accessed and charged the small additional fee for use of the follow me service; see also 0013, the pseudo name is used as a unique key to access an associated user profile)

- ✓ if the forwarding service account is maintained, debiting the account automatically in an appropriate amount and forwarding the post to an addressee destination address (see at least Lubart, 0014, the follow me mail service allows a user to define where mail objects that are addressed to a registered pseudo name are delivered. a user can modify their profile. And see at least 0078, if a mail object is sent as second class mail Hadley's franking profile is accessed and charged the small additional fee for use of the follow me service)

Schoeffler teaches:

- ✓ if the destination TAG ID is expired, automatically determining if an addressee of the post maintains a forwarding service account (see at least Schoeffler, 0028, the forwarding is implemented using an address which is known invalid. See also 0047, each old address must either be unique or have a key to distinguish it from other users. Further, see also 0088, the sender seeking to have a letter forwarded could send it to the forwarding

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service using the original address as an alias. If Jane has registered, that service will then forward the letter.)

One of ordinary skill in the art would have recognized that applying the known technique of Schoeffler to Lubart would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Schoeffler to the teaching of Lubart would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such technique. Further, applying if the destination TAG ID is expired, automatically determining if an addressee of the post maintains a forwarding service account to Lubart would have been recognized by one of ordinary skill in the art as resulting in an improved system that uses invalid address as an alias (Schoeffler, 0028).

9. As per claim 7, Lubart discloses an apparatus for forwarding post, comprising:

- ✓ means for scanning an address face of the post for a TAG ID and consulting a database for records related to the TAG ID, the records indicating said TAG ID is expired and if a redirection fee has been paid (see at least Lubart, 0014, the follow me mail service allows a user to define where mail objects that are addressed to a registered pseudo name are delivered. a user can modify their profile. and see at least 0022, each profile and one or more sub profile comprise a valid date range defining when the profile and one or more sub profiles are active and therefore a user can set a date range for a mail service. And see at least 0078, if a mail

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object is sent as second class mail Hadley's franking profile is accessed and charged the small additional fee for use of the follow me service)

- ✓ means for automatically debiting said account in an appropriate amount and forwarding the post to an addressee destination address if said forwarding service account is maintained (see at least Lubart, 0014, the follow me mail service allows a user to define where mail objects that are addressed to a registered pseudo name are delivered. a user can modify their profile. And see at least 0078, if a mail object is sent as second class mail Hadley's franking profile is accessed and charged the small additional fee for use of the follow me service)

Schoeffler teaches:

- ✓ means for automatically determining if an addressee of the post maintains a forwarding service account if said TAG ID is expired (see at least Schoeffler, 0028, the forwarding is implemented using an address which is known invalid. See also 0047, each old address must either be unique or have a key to distinguish it from other users. Further, see also 0088, the sender seeking to have a letter forwarded could send it to the forwarding service using the original address as an alias. If Jane has registered, that service will then forward the letter.), and

One of ordinary skill in the art would have recognized that applying the known technique of Schoeffler to Lubart would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Schoeffler to the teaching

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of Lubart would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such technique. Further, applying if the destination TAG ID is expired, automatically determining if an addressee of the post maintains a forwarding service account to Lubart would have been recognized by one of ordinary skill in the art as resulting in an improved system that uses invalid address as an alias (Schoeffler, 0028).

**10. Claims 2-3, 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lubart in view of Schoeffler, further in view of Nielsen.**

**11.** As per claim 2, Lubart discloses the method according to claim 1, but does not explicitly disclose further comprising the step of automatically offering a forwarding service account to said addressee if said addressee does not maintain a forwarding service account. Nielsen does not explicitly teach offering a forwarding service account to said addressee if said addressee does not maintain a forwarding service account. Nielsen, however, teaches offering a forwarding service to customer if said customer does not maintain a sufficient funded service account (see at least Nielsen, Fig. 3, step 315-323, wherein sender will be asked to pay for update if there is no sufficient fund in account).

Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to make the obvious variation from offering a forwarding service to customer if said customer does not maintain a sufficient funded service account to offering a forwarding service account to said addressee if said addressee does not maintain a forwarding service

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account because having the forwarding service would not take into effect if the account is under funded, as if the user has never registered in the first place.

One of ordinary skill in the art would have recognized that applying the known technique of Nielsen to Lubart would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Nielsen to the teaching of Lubart would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such technique. Further, applying offering a forwarding service to customer if said customer does not maintain a sufficient funded service account to Lubart would have been recognized by one of ordinary skill in the art as resulting in an improved system that would allow more efficient process (see at least Nielson, column 1, line 33-47)

*12.* As per claim 3, Lubart further discloses the method according to claim 2, further comprising the step of not forwarding the post to an addressee destination address if said addressee does not maintain a forwarding service account (see at least Lubart, 0022, a user can set a date range for a mail service and after expiry of the date range the mail service will revert back to a predate range profile).

*13.* As per claim 8, Lubart discloses the apparatus according to claim 1, but does not explicitly disclose further comprising means for automatically offering a forwarding service account to said addressee if said addressee does not maintain a forwarding service account. Nielsen, however, teaches offering a forwarding service to customer if said customer does not



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maintain a sufficient funded service account (see at least Nielsen, Fig. 3, step 315-323, wherein sender will be asked to pay for update if there is no sufficient fund in account).

Therefore, it would have been obvious for one with ordinary skill in the art at the time of the invention to make the obvious variation from offering a forwarding service to customer if said customer does not maintain a sufficient funded service account to offering a forwarding service account to said addressee if said addressee does not maintain a forwarding service account because having the forwarding service would not take into effect if the account is under funded, as if the user has never registered in the first place.

One of ordinary skill in the art would have recognized that applying the known technique of Nielsen to Lubart would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Nielsen to the teaching of Lubart would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such technique. Further, applying offering a forwarding service to customer if said customer does not maintain a sufficient funded service account to Lubart would have been recognized by one of ordinary skill in the art as resulting in an improved system that would allow more efficient process (see at least Nielson, column 1, line 33-47)

**14.** As per claim 9, Lubart further discloses the apparatus according to claim 2, further comprising means for not forwarding the post to an addressee destination address if said addressee does not maintain a forwarding service account (see at least Lubart, 0022, a user can

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set a date range for a mail service and after expiry of the date range the mail service will revert back to a predate range profile).

**15. Claims 4, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lubart in view of Schoeffler, further in view of Nielsen, even further in view of Kuebert et al. (hereinafter Kuebert, US 20020165729 A1).**

**16.** As per claim 4, Lubart discloses the method according to claim 3, but does not explicitly disclose wherein said step of not forwarding further comprises the step of destroying the post. Kuebert teaches step of not forwarding further comprises the step of destroying the post (see at least Kuebert, 0055, alternatively, the sender may instruct the shipper to destroy mail item).

One of ordinary skill in the art would have recognized that applying the known technique of Kuebert to Lubart would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Kuebert to the teaching of Lubart would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such technique. Further, applying the step of destroying the post to Lubart would have been recognized by one of ordinary skill in the art as resulting in an improved system that would be cheaper (Kuebert, 0055).

**17.** As per claim 10, Lubart discloses the apparatus according to claim 9, but does not explicitly disclose wherein said means for not forwarding further comprises means for destroying the post. Kuebert teaches means for not forwarding further comprises the means for destroying

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the post (see at least Kuebert, 0055, alternatively, the sender may instruct the shipper to destroy mail item).

One of ordinary skill in the art would have recognized that applying the known technique of Kuebert to Lubart would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Kuebert to the teaching of Lubart would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such technique. Further, applying the step of destroying the post to Lubart would have been recognized by one of ordinary skill in the art as resulting in an improved system that would be cheaper (Kuebert, 0055).

**18. Claims 5, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lubart in view of Schoeffler, further in view of Nielsen, even further in view of Kuebert, even further in view of Webb (US 20040020978 A1).**

**19.** As per claim 5, Lubart discloses the method according to claim 4, but does not explicitly disclose wherein said step of not forwarding further comprises a pre-selected time delay prior to destruction of said post. Webb teaches having a pre-selected time delay prior to destruction of said post (see at least Webb, 0003-0004, when the mail box door is closed, the process is started. The process run for a prescribed time sufficient to destroy any biological organisms. The process can start after an adjustable delay.)

One of ordinary skill in the art would have recognized that applying the known technique of Webb to Lubart would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Webb to the teaching of Lubart

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would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such technique. Further, applying having a pre-selected time delay prior to next action to ensure user having a pre-selected time delay prior to destruction of said post to Lubart would have been recognized by one of ordinary skill in the art as resulting in an improved system that would allow better safety.

**20.** As per claim 11, Lubart discloses the apparatus according to claim 10, but does not explicitly disclose wherein said means for not forwarding further comprises a pre-selected time delay prior to destruction of the post.

Webb teaches having a pre-selected time delay prior to destruction of said post (see at least Webb, 0003-0004, when the mail box door is closed, the process is started. The process run for a prescribed time sufficient to destroy any biological organisms. The process can start after an adjustable delay.)

One of ordinary skill in the art would have recognized that applying the known technique of Webb to Lubart would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Webb to the teaching of Lubart would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such technique. Further, applying having a pre-selected time delay prior to next action to ensure user having a pre-selected time delay prior to destruction of said post to Lubart would have been recognized by one of ordinary skill in the art as resulting in an improved system that would allow better safety.

**21. Response to Argument**

22. Regarding Applicant's argument directed to prior art Lubart,

23. **Applicant's arguments have been fully considered but they are not persuasive.**

24. As per Applicant's argument that even a machine readable pseudo name is not a TAG ID (see at least Lubart, 0013, the pseudo name is used as a unique key to access an associated user profile. Further, see also 0062, a pseudo name is surrounded by //. Therefore, a pseudo name is a code that distinguishes the letter on which it is printed over all other letters as Applicant describes on page 7 of the Remark).

25. As per Applicant's argument that pseudo name does not expire (see at least Lubart, 0013, the pseudo name is used to access user profile; and see 0022, each profile comprise a valid date range. Therefore, the profile associated with pseudo name has an expiration date. Since pseudo name is used to retrieve profile, it is as if the pseudo name expires. In addition, see cited section of Schoeffler reference for additional teaching regarding the limitation).

26. As per Applicant's argument that Lubart does not disclose the feature if a redirection fee has been paid (In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., if a redirection fee has been paid) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claim merely recites to debit account in appropriate amount. See at least 0078 of Lubart for the feature

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(if a mail object is sent as second class mail Hadley's franking profile is accessed and charged the small additional fee for use of the follow me service)).

27. As per Applicant's argument that Lubart does not disclose any teaching that any action is taken upon the expiry of a TAG ID (see at least Lubart, 0022, after expiry of the date range, the mail service will revert back to a predate range profile).

28. As per Applicant's argument directed to prior art Goodman

29. **Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.**

30. Applicant's argument is moot in view of new prior arts Schoeffler and Webb.

31. As per Applicant's argument directed to hindsight reconstruction

32. **Applicant's arguments have been fully considered but they are not persuasive.**

33. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

34. **Conclusion**

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Chen whose telephone number is (571)270-5499. The examiner can normally be reached on Mon-Thu 6:30-5:00 Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571)272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G.C./

/JOHN W HAYES/

Supervisory Patent Examiner, Art Unit 3628